

AMENDMENTS TO THE DRAWINGS

Please substitute the originally-filed drawings with the attached replacement drawing sheets "1/8," "2/8," "3/8," "4/8," "5/8," "6/8," "7/8," and "8/8" (that are each entitled "*REPLACEMENT SHEET*") setting forth formalized versions of Figures 1-11.

Attachment: Replacement sheets

REMARKS

Applicant has carefully studied the detailed Office Action mailed May 22, 2006 and thanks Examiner Kim for review of the pending claims. Claims 1-17 were pending and are currently rejected. In this paper, claim 4 has been amended. Claims 18-21 have been added. Applicant has also amended the originally-filed specification starting at page 7, line 18 and ending at page 8, line 1 to correct minor typographical informalities. The originally-filed drawings have been replaced with drawing sheets 1/8 – 8/8 to provide formalized versions of Figures 1-11. No new matter has been added. Applicant respectfully requests reconsideration of the present application in view of the foregoing clarifying amendments and the following remarks.

I. Formal Matters

A. Please change the attorney docket number in the record from 8200.847 to 215407-106243 so as to correctly reflect the docket number in relation to new prosecuting attorneys/agents associated with Customer No. 44200.

B. Claim 4 has been amended in order to clearly define the claimed subject matter of the invention. More specifically, claim 4 was indefinite and has been amended to provide correct antecedent basis in reference to the “directional fluid insert” recited in claim 1. Entry of the foregoing amendment is respectfully requested.

C. The specification starting at page 7, line 18 and ending at page 8, line 1 has been amended to correct typographical informalities. More specifically, the specification starting at page 7, line 18 and ending at page 8, line 1 included typographical errors pertaining to reference numerals – i.e., the reference to “downstream edges 62” and “upstream edges 64” has been changed to “downstream edges 48” and “upstream edges 46.” Entry of the foregoing amendments are respectfully requested.

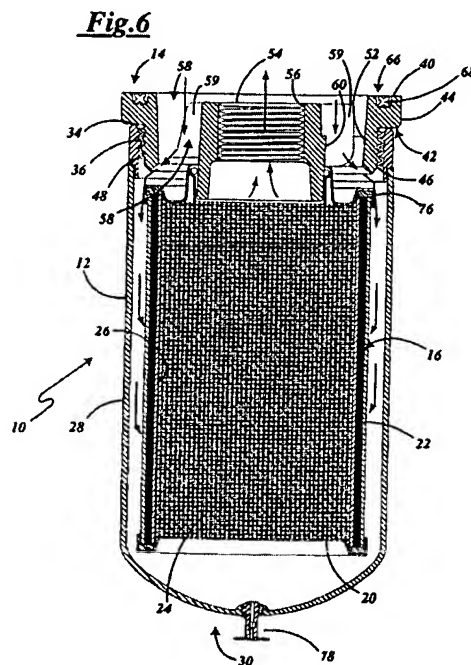
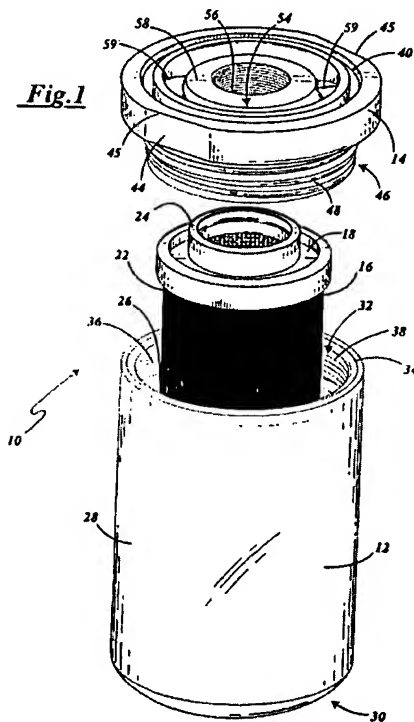
D. Replacement drawing sheets 1/8, 2/8, 3/8, 4/8, 5/8, 6/8, 7/8, and 8/8 containing formalized versions of Figures 1-11, have been submitted. Entry of the foregoing amendments are respectfully requested.

II. Claim Rejections Under 35 U.S.C. §103

A. Claims 1-6 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,423,225 to Wong et al. ("Wong") in view of U.S. 5,785,850 to Lynch ("Lynch"). For at least the following reasons, Applicant respectfully traverses the rejection.

Independent claim 1 recites, *inter alia*, "a directional fluid insert having at least one of fin disposed between said first end of said filter element and said end plate." Applicant agrees with the Office Action that Wong does not disclose that the fin is disposed between the first end of the filter element and the end plate. However, the Office Action purports that Lynch teaches "a filter assembly comprising fins (#59) disposed [sic] first end of the filter element (#16) and the end plate (#40)." See Office Action at Page 2. Applicant respectfully traverses that proposition.

Applicant respectfully submits that "#40" in Lynch is merely an upper planar surface of a cylindrical lid 14. Additionally, Applicant respectfully submits that the fins ("#59") segment an annular fluid passage 58 of the cylindrical lid 14. See Figures 1, 6, and col. 4, lines 34-37 and 55-63.



Accordingly, when looking to the explicit teachings as disclosed in Lynch, the alleged “end plate (#40)” actually includes the “fins (#59).” Therefore, Applicant asks how Lynch can provide a teaching or suggestion of the claimed feature of “*a directional fluid insert having at least one of fin disposed between said first end of said filter element and said end plate*” when the so-called end plate in Lynch includes fins? Additionally, when referring to Figure 6 in Lynch, the fins 59 radially circumscribe a central bore 54 and occupy the same plane of the so-called end plate (i.e. cylindrical lid 14); as a result, it is completely impossible for the “fins (#59)” to be disposed between the first end of the filter element and the end plate. Thus, there is no teaching, suggestion, or motivation to combine the teachings of Wong with Lynch to arrive at the claimed subject matter of the present invention.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *Ex parte Gottling* (B.P.A.I. 2005).

For at least these reasons, Applicant submits that a prima facie case obviousness under § 103(a) has not been established and the rejection as to independent claim 1 should be withdrawn. Claims 2-6 and 9 depend from claim 1, and include additional patentably distinct limitations. Therefore, claims 2-6 and 9 are also patentable.

Thus, Applicant respectfully requests the withdrawal of the rejection with respect to claims 1-6 and 9.

B. Claims 1-3, 5-9, and 11-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,761,822 to Rhyne et al. (“Rhyne”) in view of Lynch. For at least the following reasons, Applicant respectfully traverses the rejection.

Independent claim 1 recites, *inter alia*, “*a directional fluid insert having at least one of fin disposed between said first end of said filter element and said end plate.*” Applicant agrees with the Office Action that Rhyne does not disclose that the fin is disposed between the first end of the filter element and the end plate. However, the Office Action purports that Lynch teaches “*a filter assembly comprising fins (#59) disposed [sic] first end of the filter element (#16) and the end plate (#40).*” See Office Action at Page 4. Applicant respectfully traverses that proposition.

Applicant respectfully points to the assertions provided above in section II, sub-section A. regarding the absent teaching in Lynch. Accordingly, there is no teaching, suggestion, or motivation to combine the teachings of Rhyne with Lynch to arrive at the claimed subject matter of the present invention.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *Ex parte Gottling* (B.P.A.I. 2005).

For at least these reasons, Applicant submits that a prima facie case obviousness under § 103(a) has not been established and the rejection as to independent claim 1 should be withdrawn. Claims 2-3, 5-9 and 11-15 depend from claim 1, and include additional patentably distinct limitations. Therefore, claims 2-3, 5-9 and 11-15 are also patentable.

Thus, Applicant respectfully requests the withdrawal of the rejection with respect to claims 1-3, 5-9, and 11-15.

C. Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Lynch and in further view of U.S. 5,938,921 to Janik et al. ("Janik"). For at least the reasons noted above under section II, sub-sections A. and B., the Office Action has failed to establish a prima facie case of obviousness with respect to independent claim 1. Claim 10 depends from claim 1 and includes additional patentably distinct limitations. Therefore, claim 10 is also patentable.

Thus, Applicant respectfully requests the withdrawal of the rejection with respect to claim 10.

D. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Lynch and Rhyne. For at least the following reasons, Applicant respectfully traverses the rejection.

Independent claim 16 recites, *inter alia*, "*a directional fluid insert having a substantially annular base ring formed integrally with a plurality of fins extending substantially radially from said base ring and disposed between said first end of said filter element and said end plate...said directional fluid insert is attached to said first end of said filter element by a snap fit coupling*

including a plurality of flexible mounting tabs formed integrally with and axially extending from said fins.” Applicant agrees with the Office Action that Wong does not disclose:

- that the fin is disposed between the first end of the filter element and the end plate,
- a base ring, and
- mounting tabs.

However, the Office Action purports that Lynch teaches “*a filter assembly comprising fins (#59) disposed [sic] first end of the filter element (#16) and the end plate (#40).*” Additionally, the Office Action purports that Rhyne “*teaches a filter assembly comprising a directional fluid insert includes [sic] a substantially annular base ring (#140) formed integrally with a plurality of fins [sic] that the snap fit coupling includes a plurality of flexible mounting tabs (#142) formed integrally with an axially extending [sic] from the directional fluid insert.*” See Office Action at Page 6. The Office Action also goes on to state that “*the mounting tabs project lengthwise in an inward direction from the band which is unitary with the fins (Col. 5, Lines 10-19). However the tabs have a thickness which extends in an axial direction [sic] the fins extend in an axial direction (Fig. 4).*” See Office Action at Page 8. Applicant respectfully traverses that proposition.

Firstly, Applicant respectfully points to the assertions provided above in section II, subsection A. regarding the absent teaching in Lynch. Accordingly, there is no teaching, suggestion, or motivation to combine the teachings of Wong with Lynch to arrive at the claimed subject matter of the present invention.

Secondly, Applicant respectfully submits that Rhyne’s specification does not provide a teaching or suggestion of a snap fit coupling as alleged by the Office Action. As disclosed in the originally-filed specification at page 8 lines 3-8, “*the directional fluid insert 40 is formed integrally with a plurality of axially extending mounting tabs 52 having a spring resistance.*” “*As can be seen in Fig. 7, each of mounting tabs 52 has a detent, such as a bulged leading edge 54 provided at a distal end thereof, adapted to securely engage the end cap 21a at the first end 14a of the filter element 14 by the snap-fit connection.*” Also, see Figure 7 below as taken from replacement sheet 6/8 of the drawings filed with this paper. In view of the above teachings, Applicant respectfully points the Office Action to new claims 18-21, which are added in this paper. Applicant respectfully requests full examination and consideration of these teachings.

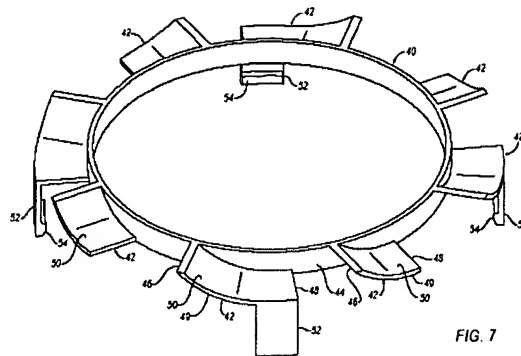


FIG. 7

The Office Action, however, indicates that the claimed feature of a snap fit coupling is shown at tabs 142 that project from an annular band 140 in Rhyne. Applicant respectfully disagrees. Referring to col. 5, lines 14-19 of Rhyne, it is explicitly stated that “*The annular band 140 has a plurality of inwardly projecting tabs 142 which extend radially over and engage the first end cap 48 in order to retain the array 122 of fins 120 adjacent to the first end cap 48 at the top of the first filter element 40.*” When referring to the above explicitly-stated teaching and what is shown in Figure 5 below (which is the only showing of tabs 142 in Lynch), it is apparent that there is no teaching or suggestion of a snap fit coupling in Rhyne.

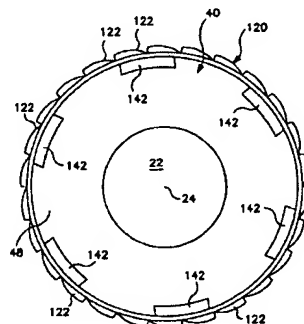


FIG. 5

Additionally, Applicant respectfully traverses the assertion made by the Office Action on Page 8 in the “Response to Arguments” section where it is stated that Rhyne discloses flexible mounting tabs having a thickness. There is absolutely no mention whatsoever in Rhyne of the tabs 142 being *flexible* or having a *thickness*. Even further, Rhyne does not provide a cross-sectional view of the tabs 142 to provide a suggestion for these alleged teachings. Thus, Applicant respectfully submits that the Office Action is misrepresenting Rhyne’s teachings and introducing inaccurate statements into the record that do not arise from Rhyne. A correct reading of Rhyne and withdrawal of the remarks in the “Response to Arguments” section regarding the flexibility and thickness of Rhyne’s tabs 142 is respectfully requested. Thus,

Applicant respectfully submits that there is no teaching, suggestion, or motivation to combine the teachings of Wong and Lynch with Rhyne to arrive at the claimed subject matter of the present invention.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *Ex parte Gottling* (B.P.A.I. 2005).

For at least these reasons, Applicant submits that a prima facie case obviousness under § 103(a) has not been established and the rejection as to independent claim 16 should be withdrawn. Thus, Applicant respectfully requests the withdrawal of the rejection with respect to claim 16.

E. Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Rhyne and Lynch. For at least the following reasons, Applicant respectfully traverses the rejection.

Independent claim 17 recites, *inter alia*, “a directional fluid insert having a substantially annular base ring formed integrally with a plurality of fins extending substantially radially from said base ring and a substantially annular outer ring substantially concentric to said base ring and connected thereto by a plurality of substantially radial ridges...wherein said directional fluid insert is attached to said first end of said filter element by a snap fit coupling including a plurality of flexible mounting tabs formed integrally with and axially extending from said outer ring; wherein said directional fluid insert is formed as a single-piece plastic molding including said snap fit coupling.” Applicant agrees with the Office Action that Wong does not disclose:

- that the fin is disposed between the first end of the filter element and the end plate,
- a base ring,
- an outer ring, and
- mounting tabs.

However, the Office Action purports that Lynch teaches “a filter assembly comprising fins (#59) disposed [sic] first end of the filter element (#16) and the end plate (#40) and comprising an outer ring (Fig. 4, #46) connected to base ring (#60).” Additionally, the Office Action purports that Rhyne “teaches a filter assembly comprising a directional fluid insert includes [sic] a

substantially annular base ring (#140) formed integrally with a plurality of fins [sic] that the snap fit coupling includes a plurality of flexible mounting tabs (#142) formed integrally with an axially extending [sic] from the directional fluid insert.” See Office Action at Page 6. The Office Action also goes on to state that *“the mounting tabs project lengthwise in an inward direction from the band which is unitary with the fins (Col. 5, Lines 10-19). However the tabs have a thickness which extends in an axial direction [sic] the fins extend in an axial direction (Fig. 4).”* See Office Action at Page 8. Applicant respectfully traverses that proposition.

Firstly, Applicant respectfully points to the assertions provided above in section II, sub-section D. regarding the absent teaching in Rhyne. Accordingly, there is no teaching, suggestion, or motivation to combine the teachings of Wong and Lynch with Rhyne to arrive at the claimed subject matter of the present invention.

Secondly, Applicant respectfully points to the assertions provided above in section II, sub-section A. regarding the absent teaching in Lynch. Regarding the alleged teaching of the fins connecting a base ring and an outer ring, Lynch’s fins are still placed in a radially circumscribing position about a central bore 54, occupying the same plane of the so-called end plate. As a result, it is completely impossible for the “fins (#59)” to be disposed between the first end of the filter element and the end plate. Thus, there is no teaching, suggestion, or motivation to combine the teachings of Wong and Rhyne with Lynch to arrive at the claimed subject matter of the present invention.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *Ex parte Gottling* (B.P.A.I. 2005).

For at least these reasons, Applicant submits that a prima facie case obviousness under § 103(a) has not been established and the rejection as to independent claim 17 should be withdrawn. Thus, Applicant respectfully requests the withdrawal of the rejection with respect to claim 17.

CONCLUSION

For all of the above reasons, Applicant submits the specification and claims are now in proper form, and that the claims presented define patentably over the prior art. Therefore, Applicants submit that this application is now in condition for allowance, and such action is respectfully solicited.

If for any reason the application is not believed to be in full condition for allowance, the Examiner is earnestly requested to contact the undersigned.

Enclosed is a fee transmittal setting forth fees due with the filing of this paper. However, in the event any additional fees are due with the filing of this paper, please charge our Deposit Account No. 50-3145, under Order No. 215407-106243 from which the undersigned is authorized to draw.

Dated: Sept 21, 2006

Respectfully submitted,

By 

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